

cont. Cf.
B³
attachment means comprises a pair of support hooks for grasping the rack arm in a manner that allows the containment volume to be supported through gravity impingement, without the necessity for permanent fasteners.

B⁴
5. The vehicle lift rack mounted tool organizer of Claim 4, wherein said pair of support hooks are laterally adjustable in size from between 3 inches to 5-1/2 inches.

REMARKS

Reconsideration of the application as amended is respectfully requested.

The examiner respectfully rejected Claims 1-10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, and 3-5 have been amended so as to overcome the aforementioned rejection under 35 U.S.C. 112, second paragraph.

The examiner respectfully rejected Claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by Buckley.

In undertaking to determine whether one reference anticipates another under 35 U.S.C. 102(b), a primary tenet is that the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention

must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Many differences exist between the invention claimed in Buckley and the currently claimed invention. To briefly summarize the distinguishing features and characteristics between the two, Buckley teaches a ladder supportable tool storage container.

As to Claim 1, the Examiner states that figure reference number 112 from Buckley anticipates the present inventions claim to a support means for a pneumatic tool. However, the Examiner’s reliance on the figure reference number 112 (a general purpose storage compartment) from Buckley seems rather broad, as the general purpose storage compartment may store conceivably anything .

Additionally, Buckley’s Claim 1 claims a plurality of storage compartments having a general rectangular shape. However, the present invention claims a pneumatic tool support means that is not a storage compartment, but more of a loop shape.

Further, Buckley’s Claims 2-7 identify in particularity the plurality of storage components to include tape measure, paste container, cleaning brushes, cloth tray, a pencil holder and a screw driver holder, respectively. Claim 10 claims the storage compartments individually claimed in Claims 2-7, respectively, and adds a “general purpose storage bin.”

Generally, neither the Buckley specifications nor the claims identify an external support means for holding or storing tools. Buckley claims *internal* storage compartments for tools having a general rectangular shape and depth approximate to the depth of the ladder storage container. In the present invention, the storage means claimed are external orifices formed on a

lateral support plate depending from the storage device. In particular, Buckley does not specify nor claim an external support means for holding a pneumatic tool.

Regarding Claim 2, the Examiner again relies on Buckley's disclosure and claims for rejecting a slidable drawer as anticipated.

However, Buckley's Claim 1 claims a "wedge shaped swing out parts tray" which has an arcuate base and pivotally swings open. The "wedge shaped" tray is housed on either one of the two side walls of the storage container. In the present invention, a slidable drawer is provided at the base of the device which slides open (as opposed to pivoting), and has a rectangular shaped base (as opposed to arcuate).

Therefore, in light of the numerous differences between Buckley and the present invention, the examiner's rejection of Claims 1 and 2 under 35 U.S.C. 102(b) as being anticipated by Buckley is inappropriate.

The examiner respectfully rejected Claim 3 under 35 U.S.C. 102(b) as being anticipated by Walker. Walker teaches

As to Claim 3, the Examiner relies upon Walker in rejecting Claims 1 and 3 of the present invention, indicating that Walker discloses a storage volume and a lockable lid. Again, Walker discloses no *external* means for supporting tools, etc. Additionally, the way the Walker device is claimed, and its operation, the device cannot organize the storage of tools, etc., because any items placed in the storage volume of the shoe box, when hanged from a door, will collect at the bottom of the storage volume and will result in an unorganized mess.

Therefore, the examiner's rejection of Claim 3 under 35 U.S.C. 102(b) as being anticipated by Walker is inappropriate.

The examiner respectfully rejected Claims 3-4 and 6-10 under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of McGarrah. The differences with respect to Buckley have been stated above.

McGarrah teaches a hanging storage box for truck beds.

Admittedly, McGarrah discloses a hooking and storage means. However, unlike the present invention, McGarrah fails to teach an adjustable attachment means as disclosed by the present invention. In contrast, McGarrah teaches an (immobile) hanger member.

The examiner respectfully rejected Claim 5 under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of McGarrah as applied to Claims 3-4 and 6-10 above, and further in view of Hall.

However, in view of the aforementioned differences abounding between Buckley, McGarrah, and the present invention, the examiner's rejection of Claim 5 under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of McGarrah as applied to Claims 3-4 and 6-10 above, and further in view of Hall is inappropriate.

The examiner respectfully rejected Claims 3, 4, 6, 8, and 10 under 35 U.S.C. 103(a) as being unpatentable over Perkins in view of Bishop. The examiner further respectfully rejected Claims 1, 2, 7, and 9 under 35 U.S.C. 103(a) as being unpatentable over Perkins in view of

Bishop as applied to Claims 3, 4, 6, 8, and 10 above, and further in view of Yemini.

Perkins teaches a tool box for small hand tools and associated items which has a pivoting front cover and top cover.

However, Perkins fails to teach a laterally-adjustable support means connected to the storage volume for grasping a rack arm of a conventional vehicle lift rack.

The examiner argues the device taught by Perkins comprises a support means "36". However, element "36" as taught by Perkins is a *carrying handle* and not a *support means* as described by the present invention.

Bishop teaches a tool storage and transport system for keeping and transporting tools and equipment.

Admittedly, Bishop discloses box hangers and bin hangers. However, unlike the present invention, Bishop fails to teach a pair of *laterally-adjustable* support hooks connected to the storage volume for grasping a rack arm of a conventional vehicle lift rack. In contrast, Bishop teaches that the "box hangers 37 and bin hangers 41 are fixedly attached to the box 30 and bins 40 . . ." Col. 4, lines 15-16.

Thus, in view of the numerous difference between Perkins, Bishop, and the present invention, the examiner's rejection of Claims 3, 4, 6, 8, 10 and Claims 1, 2, 7, and 9 under 35 U.S.C. 103(a) is inappropriate.

The examiner respectfully rejected Claims 1, 2, 7, and 9 under 35 U.S.C. 103(a) as being unpatentable over Perkins in view of Bishop as applied to Claims 3, 4, 6, 8, and 10 above, and

further in view of Schmidt. The examiner still further respectfully rejected Claim 5 under 35 U.S.C. 103(a) as being unpatentable over Perkins in view of Bishop as applied to Claims 3, 4, 6, 8, and 10 above, and further in view of Hall.

In light of the aforementioned differences denoted between Perkins, Bishop and the present invention, the rejection of Claims 1, 2, 7, and 9 under 35 U.S.C. 103(a) as being unpatentable over Perkins in view of Bishop as applied to Claims 3, 4, 6, 8, and 10 above, and further in view of Schmidt, including the rejection of Claim 5 under 35 U.S.C. 103(a) as being unpatentable over Perkins in view of Bishop as applied to Claims 3, 4, 6, 8, and 10 above, and further in view of Hall is inappropriate based upon the aforementioned distinguishing features and characteristics.

Therefore, based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining

the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the examiners arguments that would suggest the desirability or obviousness of the combination of features of the vehicle lift rack mounted tool organizer. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements.

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To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

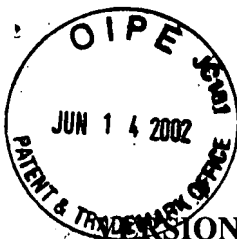
Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

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In the Claims

Please amend the following claims by deleting the language which is enclosed in brackets "[]" and inserting the language which is underlined "_____".

1.(Twice Amended) A vehicle lift rack mounted tool organizer adapted for use with a [conventional] vehicle lift rack [of a type] having rack arms, said organizer comprising:

[a storage volume, said storage volume formed by a bottom connected to a plurality of vertical sidewalls and having an articulated lid,] a plurality of vertical sidewalls perpendicularly depending from a bottom and having an articulated lid in which said sidewalls, said bottom and said lid form a storage volume;

[support means] an adjustable attachment means depending from said storage volume connected to said storage volume for grasping the rack arm in a manner that allows said organizer to be supported through gravity impingement extending cantilever outward from said support means in a manner that hangs below a horizontal level of the rack arm;

a pneumatic driving tool support means for supporting pneumatic driving tools;

a tool support means for supporting tools formed by a lateral support plate;

a cup support means for supporting cups; and

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a rag support means for supporting rags.

3.(Twice Amended) A vehicle lift rack mounted tool organizer comprising:

[a support means] an adjustable attachment means for mounting to support arms of [an otherwise conventional] a vehicle lift rack; and

a main containment volume formed [in a boxlike fashion] formed by a plurality of vertical sidewalls perpendicularly depending from a bottom and having an articulated lid, and extending cantilever outward from said support means in a manner that hangs below the horizontal level of said the rack arm;

a hinged, lockable lid affixed to and covering said main containment volume.

4.(Once Amended) The vehicle lift rack mounted tool organizer of Claim 4, wherein said [support means] adjustable attachment means comprises a pair of support hooks[,] for grasping the rack arm in a manner that allows the containment volume to be supported through gravity impingement, without the necessity for permanent fasteners.

5.(Twice Amended) The vehicle lift rack mounted tool organizer of Claim 4, wherein said pair of support hooks are laterally adjustable in size, from between 3 inches to 5-1/2 inches [in order to accommodate various standard makes of lift racks currently commercially available].